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Bezos (U.S. Patent No. 6,029,141), repeating *verbatim* all of the arguments advanced by the Examiner in the September 28, 2004 Office Action to support his prior rejection of originally filed claims 1 – 52 under 35 U.S.C. §103(a) as being obviousness over *Shane* in view of *Bezos*.

The Examiner's current rejection of amended claims 1 – 52 under §103(a) over *Shane* in view of *Bezos* is respectfully traversed. In this regard, Applicant repeats the reasons advanced in the February 23, 2005 Amendment, as supplemented below, as to why claims 1 – 52 are patentable over *Shane* in view of *Bezos*, which were advanced in response to the Examiner's prior obviousness rejection of originally filed claims 1 – 52 under §103(a) over these same references.

For a claimed invention to be obvious over a combination of prior art references, the Federal Circuit has held that there must be some suggestion, motivation or teaching in the prior art that would have led one of ordinary skill in the art to combine the references to produce the claimed invention. *E.g., Ashland Oil, Inc. v. Delta Resins & Refracs.*, 776 F.2d 281, 293 (Fed. Cir. 1985). In this regard, the Federal Circuit has identified three possible sources for a motivation to combine references:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for

combination in the matter claimed. This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.

In re Rouffet, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998).

In combining the *Shane* and *Bezos* references to reject claims 1 – 52 under §103(a), the Examiner does not rely on any of the three possible sources of motivation to combine identified by the Federal Circuit. In particular, the Examiner does not rely on (1) the teachings of the prior art references themselves, (2) the knowledge of persons of ordinary skill in the art, or even (3) the nature of the problem to be solved.

Rather, the Examiner first states that "an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the *Bezos*' [sic] teachings into the system of *Shane* so as to . . .", whereupon the Examiner then provides a description of the *Bezos* system in the form of a single sentence that spans three pages of the Final Office Action. See October 31, 2005 Final Office Action, pages 10 through 12. It is respectfully submitted that, in doing so, the Examiner has failed in his burden of demonstrating why one of ordinary skill in the art would combine these references so as to render the claimed invention obvious. But, even assuming, *arguendo*, that the Examiner properly combined the cited *Shane* and *Bezos* references, the result would not be the invention of the present application, as described in independent claims 1, 25 and 39 of the present application.

Independent claims 1, 25 and 39 recite (1) a mailer for each potential customer having printed on it a login name for the potential customer that includes the potential customer's name, (2) a program that, when a potential customer's login name is compared with stored names, allows the matching of the login name with stored names, even in instances of mis-keyed or misspelled name entries, and (3) transmitting a standard welcome is to a potential customer, even where the potential customer's login name does not correspond to a stored name, thereby allowing access to the E-commerce website by such customers. Independent claim 25 also recites a high visibility mailer designed to get the attention of a potential customer to which it is mailed. None of these features are disclosed or suggested by either of the references cited by the Examiner, either alone or in combination.

Shane discloses a system and method for providing an interactive response to direct mail by creating a personalized web page based on a URL provided on a piece of mail. However, in *Shane's* system and method the URL mailed to a recipient contains a personal identification code for the recipient that is numerical in nature. *See, Shane*, col. 2, lns. 53-59 and col. 5, lns. 1-4. *Shane* does not disclose or suggest a URL that includes a potential customer's name, as recited in independent claims 1, 25 and 39 of the present application. An example of *Shane's* personal identification code is shown as item 56 in Figure 2 of *Shane*. The only other URL disclosed by *Shane* is the "typical URL"

discussed at col. 5, lns. 45-50, which is identified by *Shane* as
www.abc.com/myproject/mypage.htm.

Shane also does not teach the use of a program that allows the matching of a login name with stored names, even in instances of mis-keyed or misspelled name entries, as also recited in independent claims 1, 25 and 39 of the present application. *Shane's* method and system determines whether a correctly formatted personal identification code has been entered, and if it has, but no matching personal identification code is found, a web page is displayed by *Shane's* web page creator stating that the submitted personal identification code could not be found and to try again. *See, Shane*, col. 7, lns. 19-30. Ultimately, *Shane's* method and system determines whether too many unauthorized access attempts have been made. If they have, *Shane's* web page creator generates a web page which states that access to the personalized web server is temporarily unavailable. *See, Shane*, col. 6, ln. 61 to col. 7, ln. 9. This is in complete contrast to the method and system of the present invention, where, as recited in independent claims 1, 25 and 39 of the present application, a standard welcome is transmitted to a potential customer, even where the potential customer's login name does not correspond to a stored name, thereby giving the potential customer access to the E-commerce website.

These last two operating features of *Shane's* system, which are contrary to the above-noted features recited in independent claims 1, 25 and 39 of the present application, *i.e.*, (1) the program that, when a potential customer's login name is

compared with stored names, allows the matching of the login name with stored names, even in instances of mis-keyed or misspelled name entries, and (2) the transmission of a standard welcome to a potential customer, even where the potential customer's login name does not correspond to a stored name, thereby allowing access to the E-commerce website by such customers, are described in the very additional portion of *Shane's* disclosure cited by the Examiner to support his rejection of claims 1 – 52 under §103, *i.e.*, *Shane*, col. 6, ln. 36 to col. 7, ln. 49.

Finally, although *Shane* discloses the use of mailers, there is no teaching or suggestion in *Shane* of the use of a high visibility mailer, as recited in independent claim 25 and dependent claims 13, 15, 30 and 43, that is designed to get the attention of a potential customer. In one embodiment of the high visibility mailer, a post card stock is chosen having a color that contrasts with the printed letters used on the post card. The example given in the present application is a post card chosen to be a bright orange color with sharp contrast with the black lettering used for the mailing names and addresses.

Bezos et al. does not compensate for the noted deficiencies in the teachings of *Shane*. *Bezos et al.* disclose an Internet-based customer referral system that enables individuals and other business entities to market products, in return for a commission, that are sold from a merchant's website. *Bezos et al.* do not disclose or suggest a method and system for inducing potential customers to access and place orders on an E-commerce website in response to a direct mailing, much less a method and system

including the features discussed above which are recited in independent claims 1, 25 and 39 of the present application.

Because independent claims 1, 25 and 39 are not obvious over the teachings of the cited references, the remaining dependent claims, which depend either directly or indirectly from such claims, *i.e.*, claims 2-24, 26-38, and 40-52, are also not obvious over the cited references.

With regard to the Examiner's rejection of claims 6, 7, 9, 29 and 41 under §103(a) as being obvious over *Shane* in view of *Bezos*, the Examiner recognizes that these references in combination do not "explicitly mention filtering or screening a mailing list, containing recipients' names, based on the users' or recipients' income, age (or demographic information) or purchase history." Nevertheless, the Examiner, relying on "Official Notice", contends that "providing targeted information to a user or filtering or screening content to be displayed to a user based on the users' demographic data or purchase history data is well documented or taught in the art (no further disclosure is necessary here)." Final Office Action, p. 12.

Similarly, in his rejection of claims 12 – 15, 30, 31 and 42 – 45 under §103(a) as being obvious over *Shane* in view of *Bezos*, the Examiner further recognizes that these references in combination do not "explicitly mention providing the information to the user on a post card chosen or made from high visibility or bright color paper stock that contrasts with the user's name and information printed thereon." Here again, the

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Examiner, relying on "Official Notice", contends that "it is common practice to mail product information to a user via a flyer or other conventional form of mailer, chosen from white or color paper of high quality. Furthermore, printing the information on a post card, made from high visibility or bright color paper stock, as opposed to a flyer, made from a white or color premium paper is a matter of desires [sic]." Final Office Action, p. 13.

Applicant notes, however, that the Federal Circuit has held that when an Examiner makes a patentability determination that a claimed invention is obvious over the prior art, the Examiner must rely on "concrete factual evidence" to make the factual findings to support a §103(a) rejection. *See In re Zurko*, 258 Fed.3d 1379, 1385-86 (Fed. Cir. 2001). The *Zurko* decision requires an Examiner to provide concrete factual evidence to support his determination that the rejected claims are not patentable because they are obviousness over the cited prior art.

In *Zurko*, the claimed invention was directed to a method for more efficiently creating a secure or "trusted" computer environment. The Examiner rejected the claimed invention under 35 U.S.C. §103, relying on a combination of two prior art references, *i.e.*, the UNIX Operating System ("UNIX") and a program (Dunford, FILER Version 2.20 ("FILER 2")) for repeating potentially dangerous commands before execution. In sustaining the rejection, the Patent Office Board of Appeals "contended that even if the cited UNIX and FILER 2 references did not disclose a trusted path, 'it is basic knowledge

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that communication in trusted environments is performed over trusted paths' and, moreover, verifying the trusted command in UNIX over a trusted path is 'nothing more than good common sense.'" Zurko, 258 F.3d at 1385. On appeal, the Federal Circuit rejected the Board's contentions, holding:

With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

Zurko, 258 F.3d at 1385-86. (Emphasis added).

The same is true with respect to the Examiner's rejections of claims 6, 7, 9, 12 – 15, 29 – 31 and 41 – 45 under §103(a) over *Shane* in view of *Bezos* and relying on "Official Notice". Clearly, it is not proper for the Examiner to rely the above-noted assertions of Official Notice to support his §103(a) rejection of these claims. Rather, the Examiner must point to some "concrete evidence in the record" to support his assertion of obviousness. This he has not done. Nor has the Examiner shown, in his reliance on Official Notice, met his burden of showing that the "facts" asserted to be well known, or to be common knowledge in the art, are capable of "instant and unquestionable demonstration as being well-known." See MPEP §2244.03. Thus, unless the Examiner supplements the record in this application to further support his §103 rejections of claims

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6, 7, 9, 12 – 15, 29 – 31 and 41 – 45, as required by *Zurko*, for these reasons alone, such claims should be allowable.

In view of the foregoing, it is now believed that all of the claims pending in the application, *i.e.*, claims 1-52, are now in condition for allowance, which action is earnestly solicited. If any issues remain in this application, the Examiner is urged to contacted the undersigned at the telephone number listed below.

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